

REMARKS

I. Introduction

Claims 17 to 32 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the acknowledgment that all certified copies of the priority documents have been received.

II. Rejection of Claims 17 to 32 Under 35 U.S.C. § 112, First Paragraph

Claims 17 to 32 were rejected under 35 U.S.C. § 112, first paragraph, as to the enablement requirement.

The Office Action states that “[r]egarding claim 17, the limitation ‘the at least one first support surface and the at least one second support surface have a lateral clearance from each other’ and ‘the at least one first elastic element bridges the lateral clearance in the form of a first free bridge’ is not understood by an ordinary skill in the art [sic].” (Office Action, p. 2). In this regard, the Office Action further states that “[a]s best understood by the Examiner and shown in Fig. 3, the first support surface 30 is the surface of the overlapping region of the holding tab 17 and elastic member and the second support surface 31 is the overlapping region of the pocket side wall 8’ and the elastic member. However, as shown in Fig. 2, there is no lateral clearance between first support surface 30 and the at least one second support surface 31 and the disclosure does not show how the lateral clearance 32 is formed in Fig. 3. Fig. 4 shows an embodiment quite different from Fig. 2 with two holding tabs 17 on one side of the elastic member and pocket side wall 8’ on the other side.” (Office Action, pp. 2 to 3).

The present rejection is not based upon the proper standard for determining compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph. Rather, the Office Action merely conclusorily states that “the breadth of the claims and the nature of the invention is unclear, there is no drawings to described [sic] prior art, there is no direction provided by the inventor, no working example.” (Office Action, p. 3). Further, it appears that the present rejection reflects an apparent misapprehension between the distinct concepts of **enablement**, under 35 U.S.C. § 112, first paragraph, and **definiteness**, under 35 U.S.C. § 112, second

paragraph. An analysis for compliance with the **enablement** requirement requires a determination as to whether the application, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed subject matter without undue experimentation. U.S. v. Telectronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988) (“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.”). Among the factors that **must** be considered in an analysis for compliance with the enablement requirement are: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill in the art; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988). It is, however, improper to conclude that a disclosure is not enabling based on an analysis of only one of these factors while ignoring one or more of the other factors. That is, a proper analysis must consider all the evidence related to each of these factors. Rather than addressing any of these factors, the Office Action contends that certain phrases included in claim 17 are “not understood by an ordinary skill in the art [sic].” As such, the present rejection is plainly deficient with regard to the proper showing required to establish that the enablement requirement is not satisfied.

Further, Applicant respectfully submits that the Office Action has misunderstood the disclosure of the present application. The Office Action, as quoted above, apparently contends that the exemplary embodiments of Figures 3 and 4 are not the same as the exemplary embodiment of Figure 2. However, nowhere does the present application indicate that the exemplary embodiments of Figures 3 and 4 are the same as the exemplary embodiment of Figure 2. Instead, as stated explicitly in the Substitute Specification, “Figure 3 shows a schematic representation of a damping device[, and] Figure 4 shows a schematic representation of a further exemplary embodiment of a damping device.” (Substitute Specification, p. 5, lines 13 to 16). Thus, Figures 3 and 4 schematically show further exemplary embodiments of the damping device that may not necessarily be the same as the exemplary embodiment shown in Figure 2. Further, as clearly shown in

the exemplary embodiments of Figures 1, 7, and 9, a lateral clearance may be provided between the holding tabs 17 and side walls 8 and 8'. Thus, similar lateral clearances may be provided in the further exemplary embodiments of the present application, as shown and described. Therefore, Applicant respectfully submits that the subject matter of the present application is described in the Specification and the Figures "in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention."

That the Office Action reflects an apparent misapprehension of the **enablement** requirement is plainly evident from at least the following statements: "Regarding claim 17, the limitation . . . **is not understood** by an ordinary skill in the art [sic]" and "the Examiner has clearly pointed out why the disclosure of the invention **is not understood** to an ordinary skill in the art [sic]." Whether a claim limitation may be **understood** and whether a patent application specification may be **understood** are entirely irrelevant to the question of whether a claim is sufficiently enabled under 35 U.S.C. § 112, first paragraph.

Accordingly, it is respectfully submitted that the Office Action plainly fails to establish that claims 17 to 32 do not comply with the enablement requirement.

It is therefore respectfully requested that the rejection be withdrawn.

III. **Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,
KENYON & KENYON LLP

Dated: October 20, 2008

/Clifford A. Ulrich/
By: Clifford A. Ulrich, Reg. No. 42,194 for:
Gerard A. Messina
(Reg. No. 35,952)
One Broadway
New York, NY 10004
(212) 425-7200